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09/713,488	11/15/2000	Leon Wong	13768.136.1	3606

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EXAMINER
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ART UNIT	PAPER NUMBER
2157	2

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2000*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to application filed on Nov. 15, 2000. Claims 1-15 are

pending examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-5, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated

by Burgan et al., U.S. Patent No. 6,668,169 (referred to hereafter as Burgan).

As to claim 1, Burgan teaches in a computer network that includes a plurality of

networked computer systems, wherein a sending computer system sends an instant

message through a chain of one or more computer systems to a destination computer

system, a method of acknowledging delivery of the instant message, wherein the criteria

for determining the success or failure of the delivery are user specified (see col. 3 lines

64-col. 4 lines 7), the method comprising the following:

an act of the sending computer system identifying the user specified criteria for

returning a successful acknowledgement message corresponding to the instant

message to the user (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16 and col. 5

lines 40-45);

an act of the sending computer system determining whether the user specified

criteria for returning a successful acknowledgement message are met (see col. 13 lines

14-50, col. 7 lines 43-col.8 lines 16 and col. 5 lines 40-45); and

an act of the sending computer system returning a successful acknowledgment

message corresponding to the instant message only if the user specified criteria have

been met (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16, col. 5 lines 40-45 and

col. 9 lines 28-60, an instant message is sent to the subscribers according to their

portfolio existing on the server to notify the users of existence of new chat directory).

As to claim 2, Burgan teaches the method of claim 1 wherein the sending

computer system comprises a sending a client computer system associated with the

user (see col. 13 lines 14-50).

As to claim 3, Burgan teaches the method of claim 1 wherein the sending

computer system comprises a sending client computer system associated with the user

(see col. 13 lines 14-50).

As to claim 4, Burgan teaches the method of claim 3, wherein the act of the

computer system identifying the user specified criteria for returning a successful

acknowledgement message comprises the following:

an act of the sending server computer system receiving a data field representing

the user specified criteria with the instant message (see col. 13 lines 14-50); and

an act of the sending server computer system reading the data field to identify

the user specified criteria (see col. 13 lines 14-50).

As to claim 5, Burgan teaches the method of claim 1 wherein the act of the computer system identifying the user specified criteria for returning a successful acknowledgment message comprises the following:

an act of reading a data field representing the user specified criteria from a database accessible to the sending computer system (see col. 9 lines 28-60 and col. 4 lines 21-38).

As to claim 10, Burgan teaches a computer readable medium having computer executable instructions for performing the acts recited in claim 1 (see the rejection of claim 1).

As to claim 11, Burgan teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified, the method comprising the following:

a step for the sending computer system determining whether user specified criteria for returning a successful acknowledgement message corresponding to the received instant message are met (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16 and col. 5 lines 40-45); and

an act of the sending computer system returning a successful acknowledgement message corresponding to the instant message only if the user specified criteria have been met. (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16, col. 5 lines 40-45 and

col. 9 lines 28-60, an instant message is sent to the subscribers according to their

portfolio existing on the server to notify the users of existence of new chat directory)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burgan in

view of La Port et al., U.S. Patent No. 6,654,359 (referred to hereafter as La Porte).

Burgan teaches in a computer network that includes a plurality of networked

computer systems, wherein a sending computer system sends an instant message

through a chain of one or more computer systems to a destination computer system, a

method of acknowledging delivery of the instant message, wherein the criteria for

determining the success or failure of the delivery are user specified (see the rejection of

claim 1).

Burgan does not explicitly teach the limitation "the user specified criteria is a

"single hop" criteria". However La Porte teaches an acknowledgment method in a

network where the acknowledgment criteria is "single hop" criteria (see col. 16 lines 11-

50).

It would have been obvious for one of the ordinary skill in the art at the time of

the invention to modify Burgan by incorporating the "single hop" acknowledgement

criteria as taught by La Porte because doing so would allow the user to confirm that the

message has been sent and that no error has occurred on the client end of the

message.

4.   Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Burgan in view of Bartfai et al., U.S. Patent No. 6,067,567 (referred to hereafter as

Bartfai).

As to claim 7, Burgan teaches in a computer network that includes a plurality of

networked computer systems, wherein a sending computer system sends an instant

message through a chain of one or more computer systems to a destination computer

system, a method of acknowledging delivery of the instant message, wherein the criteria

for determining the success or failure of the delivery are user specified (see the

rejection of claim 1).

Burgan does not explicitly teach the limitation "the user specified criteria is a

"deep or" criteria". However Bartfai teaches a message delivery acknowledgement

method according to a user specified criteria where the criteria is "deep or" criteria (see

col. 2 lines 6-35).

It would have been obvious for one of the ordinary skill in the art at the time of

the invention to modify Burgan by incorporating the "deep or" acknowledgement criteria

as taught by Bartfai because doing so would allow the user to determine if at least one

of the recipients received the message rather than receiving a negative message and

therefore requires the user to send less messages to the users that didn't receive the message rather than sending the message to the whole group.

As to claim 8, Bartfai teaches the method of claim 7 wherein the act of determining that at least one of the intended recipients received the instant message comprises the following:

an act of the computer system transmitting message to the next computer system in the chain of computer systems along with an indication that the user specified criteria for returning a successful acknowledgement message is that at least one of the intended recipients successfully received the instant message under the "deep or" criteria (see col. 2 lines 6-35);

an act of the computer system receiving an acknowledgement message from the next computer system in the chain of computer systems indicating whether or not at least one of the intended recipients successfully received the instant message under the "deep or" or criteria (see col. 2 lines 6-35); and

an act of the computer system determining that at least one of the intended recipients has received the instant message if the acknowledgment message from the next computer system indicates that at least one of the intended recipients successfully received the instant message under the "deep or" criteria (see col. 2 lines 6-35).

As to claim 9, Bartfai teaches the method of claim 1 wherein

the user specified criteria is a "deep and" criteria, and

the act of the sending computer system determining whether the user specified

criteria for returning a successful acknowledgement message are met comprises

an act of the sending computer system determining that all of the intended recipients

successfully received the instant message under the "deep and" criteria (see col. 1 lines

40-50).

5. Claims 12-15 do not add or define any additional limitation over claims 1-11 and

therefore are rejected for similar reasons.

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Internet Messaging System And Method For Use In Computer Networks by

    Maurille, U.S. Patent No. 6,484,196

- Assignable Associate Properties For User Definable Instant Messaging Buddy

    Groups by Aravamudan et al., U.S. Patent No. 6,301,609

- Method And Apparatus For Automated Facsimile Message Confirmation by

    Choksi et al., U.S. Patent No. 6,477,243.

6. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hussein A El-chanti whose telephone number is

(703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703)305-

3900.

Hussein El-chanti

Dec. 24, 2003

ARIO ETIENNE
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